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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,370	10/16/2001	Scott Carl Smith	A-7600	3961

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EXAMINER

ALLEN, ANDRE J

ART UNIT	PAPER NUMBER
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2855

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,370

Applicant(s)

SMITH, SCOTT CARL

Examiner

Andre J. Allen

Art Unit

2855

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on app. Brief filed 6-9-04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. IN view of the appeal brief filed on 8-15-0, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this office action is non-final) or a reply under 37 CFR 1.113 (if this action is final); or
- (2) request a reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193 (b)(2).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7,9-12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsui et al in view of Kim et al.

Regarding claims 1,10 16 and 17 Tsui teaches lowering a stylus 4 to contact the sample 20 until movement of the stylus is not possible without movement of the sample (col. 7 lines 20-27), moving the stylus downward until the sample ruptures (abstract), measuring the distance traveled 8 12 by the stylus from the starting point (col. 6 line 5-9) and the rupture point, and measuring the force (col. 6 lines 10-26)(col. 7 lines 49-50)applied by the force applied by the stylus at rupture. However, Tsui et al does not teach securing the sample between a column where the stylus is longer than the said column and recording a height. Kim et al teaches securing a sample to a column 9 and 10 also a height recording at the instant of a fracture (abstract)(col. 5 lines 10-12)(col. 5 lines 58-60)(col. 7 lines 32-39) while a punch 21 (that is longer than the said column) is raised into a sample (fig. 1). It would have been obvious to one having ordinary skill in the art of material testing at the time the invention was made to modify the testing device taught by Tsui et al with a column as taught by Kim et al for the purpose of securing a test piece more efficiently while being

contacted by a testing component and recording a height to determine the amount of strain to be applied (Kim col. 5 lines 58-60 and table 1).

Regarding claims 2,3,9,11 and 12 Tsui et al does not explicitly teach lowering the punch at a constant speed, at 508.0 mm/min in particular. However Tsui does teach a material tester that includes moving an indenter to engage a specimen to apply a force. This would clearly suggest a constant speed. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus taught by Tsui et al to explicitly show lowering the indenter at a constant speed for the purpose of effectively testing the strength of a material as taught by Tsui (abstract)

Regarding claims 4,5,13 and 14 Tsui et al does not teach the sample to be a rubber glove nor a gloves finger, palm or cuff. However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a glove, finger, palm, cuff, thin film or metal since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and intended use. In re Leshim 125 USPQ 416. In this particular case any material with respect to a thin film or sheet of metal, rubber or plastic could be used to test strength and breakage.

Regarding claims 6 and 15 Tsui et al does not teach a film with a uniform thickness (fig. 1). Kim teaches a film with a uniform thickness (fig. 5). It would have been obvious to one having ordinary skill in the art of material testing at the time the invention was made to test a material with uniform thickness as taught by Kim et al for the purpose of obtain accurate and equal strength test measurements on a thin film sheet of metal, rubber or plastic.

Regarding claim 7 Tsui et al in view of Kim does not teach an equation representative of the strength of the material. However, since Kim et al is teaching testing the strength of a material, it would have been obvious to one having ordinary skill in the art of material testing to manipulate parameters recorded from the applied test to derive an equation for the purpose of providing a seamless method for a user to obtain results from test measurements.

Allowable Subject Matter

3. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 18 and 19 are cited as allowable for reasons given in the prior action dated 2-24-03

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art does not disclose nor suggest a vacuum at the bottom of the column for vacuum protection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre J. Allen whose telephone number is 571-272-2174. The examiner can normally be reached on mon-fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on 571-272-2180. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.J.A
Art Unit 2855


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